

REMARKS

Claims 11, 169-175, 178, 179, 181-208, and 220-231 are pending in this application. Claims 174, 191, and 220-231 have been amended without prejudice or disclaimer. Support for the amendments can be found throughout the specification, e.g., at page 10, lines 20-25; page 55, line 15 to page 56, line 11; and page 76, line 4 to page 77, line 10. No new matter has been added.

Withdrawn Claim Rejections

Applicants thank the Examiner for withdrawing the new matter rejection of claims 11, 169-175, 177-179 and 181-208.

Status of the Claims

Applicants note that the Office Action Summary and page 9 of the Office Action indicate that claims 169, 171-173, 175, 178, 179, and 181-190 are objected to as being dependent on rejected claims. However, double patenting rejections are made to claims 171, 173, 179, and 181-185 (Office Action at page 3). Applicants respectfully request that the Office clarify the status of these claims.

Rejections for Double Patenting

Application No. 09/735,786. The Office maintains its rejection of claims 11, 171, 173, 179, 181-185, 191-194, 207, 208, and 226-231 on the ground of nonstatutory obviousness-type double patenting over claims 118-130 of co-pending Application No. 09/735,786 (Office Action at page 3). The Office also states that “[t]his is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented” (*Id.*, emphasis in the original).

Applicants do not accede to the substance of this rejection. As noted by the Examiner, this is a provisional rejection over the co-pending Application No. 09/735,786. Accordingly, Applicants request that the Examiner follow the procedures elaborated in MPEP §§ 804.I.B and B1, which authorize advancing one application to issuance where a provisional double patenting rejection is made between two pending applications. These sections state in particular:

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in at least one of the applications.

If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. (emphases added)

Based on the amendments presented herein, Applicants expect that the provisional double patenting rejections will be "the only rejection remaining" in this application. Applicants note that the present application and Application No. 09/735,786 have the same Examiner. Further, this application has an earlier filing date than Application No. 09/735,786. Accordingly, the double patenting rejection made in this application should be withdrawn so that, of the two, the present application may be the first to issue as a patent.

Application No. 11/404,146. The Office has also rejected claims 11 and 170 on the ground of nonstatutory obviousness-type double patenting over claims 15-19 of co-pending Application No. 11/404,146 (Office Action at page 4). The Office also states that "[t]his is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented" (page 5, emphasis in the original).

Applicants do not accede to the substance of this rejection. As noted by the Examiner, this is a provisional rejection over the co-pending Application No. 11/404,146. Accordingly, Applicants request that the Examiner follow the procedures of MPEP §§ 804.IB and B1, detailed above.

Based on the amendments presented herein, Applicants expect that the provisional double patenting rejections will be "the only rejection remaining" in this application. Applicants ask that the Examiner of Application No. 11/404,146 be notified of the double patenting rejection made in this application. Further, this application has an earlier filing date than Application No. 11/404,146. Accordingly, the double patenting rejection made in this application should be withdrawn so that, of the two, the present application may be the first to issue as a patent.

35 U.S.C. § 112, First Paragraph, Written Description

The Office at pages 5-9 of the Office Action alleges that claims 174, 191-208, and 220-231 are rejected for failing to comply with the written description requirement. In particular, the Office Action at page 5 states that “[c]laims 174, 191-208, and 220-231 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.”

However, the Office fails to provide reasoning as to why claims 220-231 are rejected on this basis. Indeed, the Office at page 5 states that “SEQ ID NO:6-8 meet the written description provision of 35 USC 112, first paragraph” (emphasis added). These sequences are recited in claims 220-231. Applicants respectfully request that the Office clarify its position and indicate whether or not claims 220-231 are rejected for an alleged lack of written description. If the Office intended to reject these claims for an alleged lack of written description, Applicants submit that any subsequent Office Action rejecting claims 220-231 on that basis cannot be made final as Applicants have not had an opportunity to address the substance of a rejection of these claims based on a lack of written description.

The Office alleges that “[t]he instant claims are drawn to a broad genus of N-terminal fragments of an H3 or H4 histone proteins that can be acted upon (deacetylated by) Sir2 in the presence of NAD or an NAD-like molecule” (page 5 of the Office Action).

In the interest of expediting allowance of this application, claims 174 and 191 have been amended to recite, “wherein the N-terminal tail [or fragment] comprises amino acids 1-20 of SEQ ID NO:6; SEQ ID NO:7; or SEQ ID NO:8.”

The Office indicates that SEQ ID NOs:6-8 satisfy the written description requirement. See, e.g., the passage from page 5 of the Office Action, quoted above, and also page 6. Further, the specification as filed describes the structure of, and how to make and use, amino acids 1-20 of SEQ ID NO:6, SEQ ID NO:6, SEQ ID NO:7, and SEQ ID NO:8 (see, e.g., page 10, lines 20-25; page 55, line 15 to page 56, line 11; and page 76, line 4 to page 77, line 10).

Applicants submit that the amendments to claims 174 and 191 overcome the written description rejection and respectfully request that this rejection of claims 174 and 191, and their dependencies be withdrawn.

35 U.S.C. § 112, Second Paragraph

The Office rejects claims 220-231 as allegedly being indefinite (Office Action at page 9). Specifically, the Office alleges that the phrase “a sequence with SEQ ID NO:X” renders the claims vague and indefinite.

In the interest of expediting prosecution, Applicants have amended claims 220-231 to remove this phrase. In light of this amendment, Applicants submit that this rejection of claims 220-231 has been overcome, and respectfully request withdrawal of the same.

CONCLUSION

For at least the reasons stated above, Applicants respectfully submit that all pending claims are in condition for allowance, which action is expeditiously requested. Applicants do not concede any positions of the Examiner that are not expressly addressed above, nor do Applicants concede that there are not other good reasons for patentability of the presented claims or other claims.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. Please charge any deficiency to Deposit Account No. 50/2762.

Respectfully submitted,
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